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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,449	05/03/2002	Wolf Bertling	10848-016001	7972

7590 08/22/2005

Mark S Ellinger
Fish & Richardson
60 South Sixth Street Suite 3300
Minneapolis, MN 55402

EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,449

Applicant(s)

BERTLING ET AL.

Examiner

Ethan Whisenant, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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NON-FINAL ACTION

1. The applicant's election of **Group I (Claims 1-14 and 29-31)** with traverse in the paper(s) filed 01 JUL 05 is acknowledged. The traversal of the restriction requirement is based on the applicant's contention that the special technical feature is misunderstood by the examiner and in fact was not known in the prior art, making the lack of unity improper. The examiner has carefully considered the applicant's traversal and agrees. The lack of unity was improper. The claims have unity and, therefore, will be examined together. **Claims 1-3, and 5-33** as filed in the preliminary amendment of 14 DEC 01 are pending.

35 USC § 112- 2nd Paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

3. **Claim(s) 1-3, 5-33** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because there is no nexus between the preamble and the claim steps. Claim 1 in its preamble direct to a method which is to accomplish a particular goal. However, none of the claim steps states that this goal is accomplished. For clarity, claimed methods should recite that the purpose of the method has been attained (i.e. provide a nexus between the preamble and the claim steps).

All of the claims are indefinite in view of the numbers present in the claims (i.e. those numbers that refer to features present in the drawings and/or specification. It is unclear if the claims are limited to just those materials/features which correspond to said numbers and/or features recited in the text or are in fact of broader scope. Please clarify.

REASON FOR ALLOWANCE

4. **Claims 1-3 and 5-33** are allowable over the prior art of record because the prior art considered does not teach or reasonably suggest a method and device for identifying a first polymer which is bound to a first phase which reflects electromagnetic waves as recited in Claim 1 and 15. In particular, the closest prior art Schalkhammer et al. [US Patent No. 6,669,906 (2003)] do not teach or reasonably suggest, either alone or in combination with the other prior art considered, the method and device for identifying a first polymer as recited in Claims 1 and 15 wherein a second polymer with affinity for said first polymer is bound by way of metallic clusters to a second solid phase which solid phase is pervious to electromagnetic waves.

NON-STATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1-3, 5-6, 10-12, 14-17, 19-23** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27-28, 30, 32, 34, 44-45, 48-51, 54-58 of copending Application No. 10/333,395. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


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CONCLUSION

7. **Claim(s) 1-3, and 5-33** is/are rejected and/or objected to for the reason(s) set forth above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached at (571) 272-0745.

The Central Fax number for the USPTO is (571) 273-8300. Before faxing any papers, please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).


ETHAN WHISENANT
PRIMARY EXAMINER

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Search Notes

09 AUG 05

Databases searched: USPATFULL, USPG-PUBS and EUROPATFULL via EAST, CAlus, Medline

Reviewed the parent(s) and any search(es) performed therein : see the BIB data sheet

Reviewed, the search(es), if any, performed by prior examiners

Search terms:

Inventor(s) : e.g. Betling W?/au

Electromagnetic waves or light or laser

Metallic cluster\$ or metal cluster\$

Polymer\$

Oligonucleotide\$

probe\$

protein\$

peptide\$

antibod\$

receptor\$

ligand\$

Reflect\$

Hybridiz\$ or binding